

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

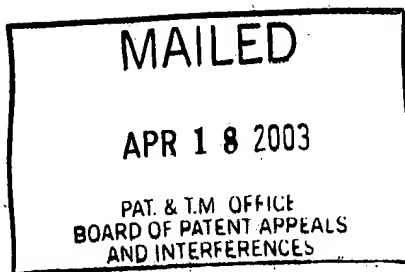
Paper No. 33

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte ISTVAN SIMON

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Appeal No. 2003-0019  
Application No. 09/136,820

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ON BRIEF

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Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

**REMAND TO THE EXAMINER**

This application is remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for action in accordance with the following comments.

**BACKGROUND**

In the preliminary amendment (Paper No. 20, filed July 19, 2001) accompanying the appellant's request for a Continued Prosecution Application (CPA), the appellant

- (1) amended the paragraph bridging pages 12 and 13 of the specification by adding the phrase "with water from a flowing water source such as, for example, a waterfall;" and
- (2) amended claim 1 to read as follows (additions underlined):

A liquid power machine comprising  
a drive means,  
an energy input means for providing energy to the drive means comprising a  
flowing water source,  
a drive output means, and  
a lever drive assembly by way of which the drive means and the drive output  
means are in engagement with each other.

In the Grounds of Rejection section of the answer (Paper No. 27, mailed August 6, 2002, pp. 3-6), the examiner

- (1) objected to the abstract as attempting to disclose a "perpetual motion" machine;
- (2) objected to the specification as not enabling one skilled in the art to make and use the invention;
- (3) objected to the specification as not setting forth the best mode contemplated by the inventor of carrying his invention;
- (4) rejected claims 1-19 under 35 U.S.C. § 101 because the disclosed invention is inoperative and therefore lacks utility; and
- (5) required the appellant to furnish a working model of his invention in order to demonstrate its operability.

### REASONS FOR REMAND

① We remand this application to the examiner to determine if the above-noted amendment (i.e., with water from a flowing water source such as, for example, a waterfall) to the specification violates the new matter prohibition of 35 U.S.C. § 112. If the examiner determines that the above-noted amendment to the specification does not involve new matter, the examiner should set forth where in the original disclosure support was found. If the examiner determines that the above-noted amendment to the specification does involve new matter, the examiner should make the appropriate objection.

② We remand this application to the examiner to determine if the above-noted amendment (i.e., a flowing water source) to claim 1 finds written description support in the original disclosure as required by the first paragraph of 35 U.S.C. § 132. If the examiner determines that the above-noted amendment to claim 1 does not violate the written description requirement, the examiner should set forth where in the original disclosure support was found. If the examiner determines that the above-noted amendment to claim 1 does violate the written description requirement, the examiner should make the appropriate rejection.

Before utility, which is a question of fact, is determined, the claims must be interpreted as a matter of law to define the invention to be tested for utility. See Raytheon

Co. v. Roper Corp., 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984). Accordingly, we remand this application to the examiner to determine the scope of the invention as follows. The examiner must state if the drive means of claim 1 is a means plus function clause under the sixth paragraph of 35 U.S.C. § 112 and if it is set forth the structure in the specification which corresponds thereto. The examiner must state if the drive output means of claim 1 is a means plus function clause under the sixth paragraph of 35 U.S.C. § 112 and if it is set forth the structure in the specification which corresponds thereto. The examiner must state if the energy input means for providing energy to the drive means comprising a flowing water source is a means plus function clause under the sixth paragraph of 35 U.S.C. § 112 and if it is set forth the structure in the specification which corresponds thereto. If the energy input means for providing energy to the drive means comprising a flowing water source is not a means plus function clause under the sixth paragraph of 35 U.S.C. § 112 the examiner must provide the broadest reasonable meaning of those words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment that may be afforded by the written description contained in the appellant's specification.<sup>1</sup>

<sup>1</sup> In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Regarding utility, a predecessor of our appellate reviewing court stated in In re Langer, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974):

a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented *must* be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter *unless* there is reason for one skilled in the art to question the objective truth of the statement of utility or its scope.

④ In the rejection of claims 1-19 under 35 U.S.C. § 101, the examiner found that the disclosed invention was inoperative and therefore lacked utility. However, it is the claimed subject matter that must be evaluated for utility not the disclosure. Accordingly, we remand this application to the examiner to either set forth why the claimed subject matter<sup>2</sup> is inoperative and therefore lacks utility or withdraw the rejection.

⑤ Lastly, we remand this application to the examiner to conduct a search. We note that the pre-printed "SEARCHED" section of the filewrapper is empty. Thus, it would appear that the examiner has not conducted a search of the prior art to determine whether or not the claimed subject matter is patentable under 35 U.S.C. §§ 102 and 103. In that regard, we note that the subject matter of claim 1 appears to be readable on a waterwheel (as used in grist mills) connected to a drive output via a lever assembly.

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<sup>2</sup> In that regard, we note that the claimed subject matter uses the transitional phrase "comprising." In addition, the claims do not appear to recite that the liquid circuit is substantially closed as set forth on page 2 of the specification.

### **CONCLUSION**

This case is being returned to the jurisdiction of the examiner for further action as appropriate. Under the circumstances recounted above, it is our view that the any new ground of rejection made by the examiner in response to this remand must be by way of reopened prosecution on the merits. Therefore, we are not authorizing a supplemental examiner's answer under 37 CFR § 1.193(b).

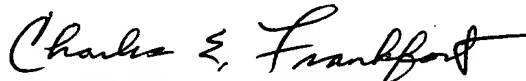
This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01 (Eighth Edition, Aug. 2001), item (D). It is important that the Board of

Patent Appeals and Interferences be promptly informed of any action affecting the appeal  
in this case.

REMANDED



IRWIN CHARLES COHEN  
Administrative Patent Judge



CHARLES E. FRANKFORT  
Administrative Patent Judge



JEFFREY V. NASE  
Administrative Patent Judge

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